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| 09/686,073 | 10/11/2000 | David Traynor | 2043.165US1 | 5507 |
| 21186 | 7590 | 02/06/2006 | EXAMINER | |
| SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402 | | | COLBERT, ELLA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/686,073 | Applicant(s) TRAYNOR ET AL. | |
| | Examiner Ella Colbert | Art Unit 3624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-15 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8-15 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/17/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4, 8-15, and 32-34 are pending in this communication filed 11/17/05 entered as Response to Non-Final Action.
2. The Correspondence Address Change filed 09/14/05 has been entered.
3. The IDS filed 11/17/05 has been considered and entered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4, 8-15, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,890,138) Godin et al, hereafter Godin in view of US 6,405,175) Ng.

Claim 1. Godin teaches, A networked sales method, including: presenting via a first network a sales screen to a user showing a plurality of price choices for an item (col. 3, lines 15-48 and fig. 1 (6 & 16). Godin failed to teach, generating a feedback indication for the item, at each of the plurality of price choices, using available supply and sales level information generated from actions of other users and conveying the feedback indication to the user on the sales screen. Ng teaches, generating a feedback indication for the item, at each of the plurality of price choices, using available supply and sales level information generated from actions of other users and conveying the feedback indication to the user on the sales screen (col. 8, lines 38-67 and col. 9, lines 19-29 and lines 40-53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to generate a feedback indication for the item, at each of the plurality of price choices, using available supply and sales level information generated from actions of other users and conveying the feedback indication to the user on the sales screen and to modify in Godin in view of Godin's sales screen showing price choices for an item and because

such a modification would allow Godin to give either positive or negative feedback about the price of an item.

Claim 2. Godin failed to teach, The method of claim 1 wherein the conveying includes displaying the feedback indication in the sales screen. Ng. Teaches, wherein the conveying includes displaying the feedback indication in the sales screen (col. 8, lines 38-55 and lines 56-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the conveying to include displaying the feedback indication in the sales screen and to modify in Godin because such a modification would allow Godin to give either positive or negative feedback about the price of an item.

Claim 3. Godin teaches, The method of claim 2 wherein the conveying includes displaying the feedback indication in the form of one of a series of different pictorial icons (col. 5, lines 41-51).

Claim 4. Godin teaches, The method of claim 1 wherein the feedback indication is associated with one or more factors selected from a group including quantities of the item sold, quantities of the item reserved at future price points, quantities of the item for which a reminder request has been entered, and the time duration incurred to sell the item (col. 3, lines 44-53).

Claim 8. Godin teaches, The method of claim 1 wherein the converting is performed continuously in near real time (col. 3, lines 65-66).

Claim 9. Godin teaches, The method of claim 1 wherein the presenting includes

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presenting time-separated price choices from a falling-price schedule (col. 6, lines 50-56).

Claim 10. Godin teaches, The method of claim 1 wherein the presenting a plurality of price choices includes displaying a present price and at least one future price, and further includes displaying a present purchase control button next to the present price and a future purchase control button next to the at least one future price (col. 3, lines 48-53).

Claim 11. Godin teaches, A network sales terminal for use in communicating with a sales server via a network, including: an item identification area responsive to the sales server via the network, a plurality of price choice selection controls for the item identified in the item identification area and having outputs provided to the sales server via the network (col. 2, lines 1-14 and lines 22-60). Godin failed to teach, a feedback indication area responsive to the sales server via the network and operative to display a feedback indication, derived from a quantity of the item available and sales of the item through other sales terminals in association with the plurality of price choices. Ng teaches, a feedback indication area responsive to the sales server via the network and operative to display a feedback indication, derived from a quantity of the item available and sales of the item through other sales terminals in association with the plurality of price choices (col. 8, lines 42-52). Ng did not expressly teach a server. Godin teaches a server (col. 1, 59-col. 2, line 14 and lines 39-63) that can be used for a sales server. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a feedback indication area responsive to the sales server via the

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network and operative to display a feedback indication, derived from a quantity of the item available and sales of the item through other sales terminals in association with the plurality of price choices and to modify in Godin because such a modification would allow Godin to such a modification would allow Godin to give either positive or negative feedback about the price of an item.

Claim 12. Godin teaches, The network sales terminal of claim 11, wherein the feedback indication area is operative to display the feedback indication in the form of one of a series of different pictorial icons (col. 5, lines 41-51).

Claim 13. Godin teaches, The network sales terminal of claim 11, wherein the feedback indication area is operative to display the feedback indication in near real time (col. 3, lines 65-66).

Claim 14. Godin teaches, The network sales terminal of claim 11, wherein the price choice selection controls are associated with time-separated price choices from a falling-price schedule (col. 6, lines 50-56).

Claim 15. This independent claim is rejected for the similar rationale as given above for claim 1.

Claim 32. Godin failed to teach, The method of claim 1, including adjusting one or more of the plurality of price choices utilizing the feedback indication. Ng teaches, including adjusting one or more of the plurality of price choices utilizing the feedback indication (col. 11, lines 13-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include adjusting one or more of the plurality of price choices utilizing the feedback indication and to modify in Godin

because such a modification would allow Godin to have the ability to enter a new lower price for a product by searching the Internet. Thus, providing feedback in the form of entering the current information and displaying it to the user.

Claim 33. Godin teaches, The method of claim 32 wherein the presenting of the plurality of price choices includes presenting the plurality of price choices as a schedule of time-separated price choices, and wherein the adjusting of the plurality of price choices includes adjusting duration between prices or adjusting an amount of at least one of the prices in the schedule (col. 5, lines 16-40).

Claim 34. Godin teaches, The network sales terminal of claim 11, wherein at least one attribute of a price choice selection control of the plurality of price choice selection controls is operative to change during an offering of an item identified in the item identification area (col. 6, lines 6-58).

Response to Arguments

6. Applicant's arguments filed 11/17/05 have been fully considered but they are not persuasive.

Applicants' argue: The Examiner has the burden under 35 U.S.C 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and to do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references has been considered but is not persuasive. Response: As for the motivation, Rationale may be in a reference or reasoned from common knowledge in

the art, scientific principles, art-recognized equivalents, or legal precedent". The reason or motivation to modify the reference may often suggest what the inventor has done but for a different purpose or to solve a different problem. It is not necessary to achieve the same advantage or result discovered by Applicants'. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); and *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning). MPEP 2144.

Issue No. 2: Applicants' respectfully submit that the Office Action did not make out a prima facie case of obviousness for at least the reason the cited prior art fails to teach or suggest all elements of the independent claims, as contended in the Office Action (OA) and adding what is taught in Ng to Godin fails to teach or suggest what is recited in claim 1 has been considered but is not persuasive. Response: The Examiner respectfully submits it is unclear as to whether Applicants' mean "A networked sales method" or "A network sales method". The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

Godin teaches, presenting via a first network a sales screen to a user showing a plurality of price choices for an item (col. 3, lines 15-48 and fig. 1 (6 & 16)). Applicants' have failed to recognize all of the cited lines in col. 3 because Applicants' have ignored that figure 4 was described. The reference is to be read in its entirety and not just the cited columns and line numbers. It is interpreted that Ng does teach the elements of claim 1 which Godin fails to teach considering Applicants' unclear and vague claim language. There appears to be words missing from the claim limitations of claim 1. Applicants' are respectfully requested to read and to correct the claim language to overcome the lack of clarity and vagueness. For example, claim 1, lines 1-6, recites "A networked sales method, ...: ... generating a feedback indication for the item, ..., using available supply and sales level information generated from actions of other users; ...". Do Applicants' mean "A network sales method, ...: generating a feedback indication for the item, ..., using available supply and sales level information generated from said actions of other users; ..." or "A network sales method, ...: generating a feedback indication for the item, ..., using available supply and sales level information generated from the actions of other users; ..."? Claim 15 has a similar problem. Claim 11 is also vague and lacks clarity. Claim 11, line 3 recites "an item identification area". It is unclear what the item identification area is. Do Applicants' mean the item identification area is a terminal screen or a computer screen?

Applicants' are respectfully reminded that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble

for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion: In this rejection of claim 1 and others, for example under Section 103 (a) of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations as best as could be understood and one or more referenced passages in the Godin and Ng references, what is well known in the art, and what is known to one having ordinary skill in the art (the skilled artisan). The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 162 USPQ 541,550-51 (CCPA 1969).<

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

There are outstanding 35 U.S.C. 112, second paragraph issues with the claims as addressed above which need clarification in the claim language and Applicants' need to particularly point out and to claim the novel feature of their invention in the independent claims. Where is this feature claimed in claims 1, 11, and 15?

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Spencer (US 6,356,909) disclosed a request for proposal (RFP and automates the process of reviewing, analyzing and presenting the results.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'E. Colbert', with a stylized flourish at the end.

E. Colbert
Primary Examiner
February 2, 2006